UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/407,126	09/27/1999	ROBERT W. BOSSEMEYER JR.	8285/314	2323

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EXAMINER
BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>03</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>06 October 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5-12,14-19 and 21-26* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5-12,14-19 and 21-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
   application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/06/2004 has been entered.

Response to Amendment

Amendment received on 10/06/2004 is acknowledged and entered. **Claims 4, 13 and 20** have previously been canceled. **Claims 1, 9, 10 and 17** have been amended. **Claims 1-3, 5-12, 14-19 and 21-26** are currently pending in the application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 5-12, 14-19 and 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alcott (US 6,324,273) in view of Panizzon (US 4,219,700) (Panizzon) and further in view of Majmudar et al. (US 4,897,866) (Majmudar).

Alcott teaches a computer-implemented method and system for ordering a telecommunication service, comprising:

As per **claims 1, 10 and 17,**

determining, in accordance with an inquiry of a party, an availability of a telecommunication feature for the party of a telecommunication network (C. 3, L. 62 – C. 4, L. 4);

in accordance with said inquiry, identifying the party of the telecommunication network and the telecommunication feature unavailable to the first party (C. 3, L. 48 – 53; C. 3, L. 62 – C. 4, L. 4);

providing availability data which indicates an availability of the telecommunication feature to a portion of the telecommunication network which serves the party (C. 3, L. 62 – C. 4, L. 4);

determining that the telecommunication feature has become available to the party based on the first data structure and the availability data (C. 4, L. 15-25). As per "storing" feature, Alcott teaches the computer-implemented method, wherein the steps of: "identifying the party of the telecommunication network and the telecommunication feature unavailable to the first party" are performed by the order processor (44), thereby obviously indicating storing step (C. 3, L. 48–53).

Alcott does not specifically teach that inputting said availability data, which indicates availability of the telecommunication feature to a portion of the telecommunication network serving the party, is occurring after completion of the first transaction; and after upgrading the portion of the telecommunication network which serves the party.

Panizzon teaches a method and system for party line subscriber interface circuit, wherein a telephone service subscriber, after inquiring for a telecommunication feature, said feature was unavailable for the subscriber, and after completing the inquiry, and after the processing the availability of said feature, was informed that said feature had become available to the subscriber (C. 2, L. 48-54; C. 9, L. 57 – C. 10, L. 7).

Majmudar teaches a method and system for telecommunication arrangement, wherein, after a subscriber selects (inquires) a desired specific telecommunication feature, the inquiry is processed, and appropriate software modules are assembled to enable the requested feature. After this event, if user lifts a handset to originate a call, the requested feature is available (C. 6, L. 1-17).

It would have been obvious to one haivng ordinary skill in the art at the time the invention was made to modify Alcott to include that inputting said availability data, which indicates an availability of the telecommunication feature, is occurring after completion of the first transaction, as taught by Panizzon, because it would advantageously improve customer service of the service providers by allowing subscribers to inquire for the desired feature only once. And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Alcott and Panizzon to include that inputting said availability data is occurring after upgrading the portion of the telecommunication network which serves the party, as taught by Majmudar, because it would advantageously allow to accommodate various needs subscribers may have, thereby make the system more attractive to customers. Information as to *first* party and *first* telecommunication feature is non-functional language and given no patentable weight. Non-functional descriptive material <u>cannot</u> render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter <u>how</u> the process steps are to be performed. The method steps, disclosed in Alcott, Panizzon and Majmudar would be performed the same regardless how many parties make inquiries for a service, and how many telecommunication features are available for the service.

Also, Alcott teaches:

As per **claims 2, 11 and 18**,

. identifying.another.party.of the telecommunication network and another ~.~~. ... .~ ·   · .. . telecommunication feature unavailable to another party, determining an availability of the telecommunication feature for another party of a telecommunication network, and determining that the telecommunication feature unavailable to another party (C. 3, L. 48 –53; C. 3, L. 62 – C. 4, L. 4). As per "storing" feature, Alcott teaches the computer-implemented method, wherein the steps of: "identifying the party of the telecommunication network and the telecommunication feature unavailable to the first

party" are performed by the order processor (44), thereby obviously indicating storing step (C. 3, L. 48–53). Information as to *second* party and *first* telecommunication feature is non-functional language and given no patentable weight. Non-functional descriptive material <u>cannot</u> render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter <u>how</u> the process steps are to be performed. The method steps, disclosed in Alcott, Panizzon and Majmudar would be performed the same regardless how many parties make inquiries for a service, and how many telecommunication features are available for the service.

As per **claims 3, 12 and 19**, identifying another party of the telecommunication network and another telecommunication feature unavailable to another party, and determining that another telecommunication feature unavailable to another party (C. 3, L. 48 –53; C. 3, L. 62 – C. 4, L. 4). As per "storing" feature, Alcott teaches the computer-implemented method, wherein the steps of: "identifying the party of the telecommunication network and the telecommunication feature unavailable to the first party" are performed by the order processor (44), thereby obviously indicating storing step (C. 3, L. 48–53). Information as to *second* party and *first* telecommunication feature is non-functional language and given no patentable weight. Non-functional descriptive material <u>cannot</u> render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter <u>how</u> the process steps are to be performed. The method steps, disclosed in Alcott, Panizzon and Majmudar would be performed the same regardless how many parties make inquiries for a service, and how many telecommunication features are available for the service.

As per **claim 5**, said method and system, comprising: prior to inputting the availability data, receiving a call from the party, and informing in the call that the first telecommunication feature is unavailable to the party (C. 1, L. 11-33; C. 3, L. 41 – C. 4, L. 4).

As per **claims 6, 14 and 21**, said method and system, wherein the first telecommunication feature comprises a telecommunication service (C. 1, L. 6-7).

As per **claims 7, 15 and 22**, said method and system, wherein the first telecommunication feature comprises a telecommunication product (C. 1, L. 6-7).

As per **claims 8, 16 and 23**, said method and system, wherein the telecommunication network comprises a telephone network (C. 1, L. 62 – C. 2, L. 12).

As per **claim 9**,

in accordance with an inquiry of a party, determining an availability of a telecommunication feature for the party of a telecommunication network (C. 3, L. 62 – C. 4, L. 4);

in accordance with said inquiry, storing a first data structure which identifies the party of the telecommunication network and the telecommunication feature unavailable to the first party (C. 3, L. 48 –53; C. 3, L. 62 – C. 4, L. 4);

providing availability data which indicates an availability of the telecommunication feature to a portion of the telecommunication network which serves the party (C. 3, L. 62 – C. 4, L. 4);

determining that the telecommunication feature has become available to the party based on the first data structure and the availability data (C. 4, L. 15-25). As per "storing" feature, Alcott teaches the computer-implemented method, wherein the steps of: "identifying the party of the telecommunication network and the telecommunication feature unavailable to the first party" are performed by the order processor (44), thereby obviously indicating storing step (C. 3, L. 48–53).

Alcott does not specifically teach that inputting said availability data, which indicates availability of the telecommunication feature to a portion of the telecommunication network serving the party, is occurring after completion of the first

transaction; and after upgrading the portion of the telecommunication network which serves the party.

Panizzon teaches a method and system for party line subscriber interface circuit, wherein a telephone service subscriber, after inquiring for a telecommunication feature, said feature was unavailable for the subscriber, and after completing the inquiry, and after the processing the availability of said feature, was informed that said feature had become available to the subscriber (C. 2, L. 48-54; C. 9, L. 57 – C. 10, L. 7).

Majmudar teaches a method and system for telecommunication arrangement, wherein, after a subscriber selects (inquires) a desired specific telecommunication feature, the inquiry is processed, and appropriate software modules are assembled to enable the requested feature. After this event, if user lifts a handset to originate a call, the requested feature is available (C. 6, L. 1-17).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Alcott to include that inputting said availability data, which indicates an availability of the telecommunication feature, is occurring after completion of the first transaction, as taught by Panizzon, because it would advantageously improve customer service of the service providers by allowing subscribers to inquire for the desired feature only once. And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Alcott and Panizzon to include that inputting said availability data is occurring after upgrading the portion of the telecommunication network which serves the party, as taught by Majmudar, because it would advantageously allow to accommodate various needs subscribers may have, thereby make the system more attractive to customers.

Also, Alcott, Panizzon and Majmudar do not specifically teach a first party, a second party and a third party, which inquire for a first, second and third features.

However, the method steps disclosed in Alcott, Panizzon and Majmudar obviously indicate continuity of the disclosed method. Information as to *first, second and third* party and *first, second and third* telecommunication features is non-functional language and given no patentable weight. Non-functional descriptive material <u>cannot</u> render non-obvious an invention that would otherwise have been obvious. *See: In re*

Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter <u>how</u> the process steps are to be performed. The method steps, disclosed in Alcott, Panizzon and Majmudar would be performed the same regardless how many parties make inquiries for a service, and how many telecommunication features are available for the service.

As per **claims 24-26,** Panizzon teaches that a telephone service subscriber, after inquiring for a telecommunication feature, said feature was unavailable for the subscriber, and after completing the inquiry, and after the processing the availability of said feature, was informed that said feature had become available to the subscriber (C. 2, L. 48-54; C. 9, L. 57 – C. 10, L. 7). The motivation to combine Alcott with Panizzon would be to advantageously improve customer service of the telephone service provider by returning the customer call for a desired telecommunication feature.

Response to Arguments

Applicant's arguments filed on 10/06/04 have been fully considered but they are not persuasive.

In response to the Applicant's argument that Alcott does not teach *in accordance with the inquiring first transaction, storing the identity of the first party and the first telecommunication feature unavailable to the first party,* it is noted that Alcott teaches: in accordance with said inquiry, identifying the party of the telecommunication network and the telecommunication feature unavailable to the first party (C. 3, L. 48 –53; C. 3, L. 62 – C. 4, L. 4). As per "storing" feature, Alcott teaches the computer-implemented method, wherein the steps of: "identifying the party of the telecommunication network and the telecommunication feature unavailable to the first party" are performed by the order processor (44), thereby obviously indicating "storing" step (C. 3, L. 48–53).

In response to the Applicant's argument that the prior art does not teach: processing the first data structure and the availability data *in response to upgrading the portion of the telecommunication network, which serves the first party,* it is noted that Majmudar teaches that, after a subscriber selects (inquires) a desired specific telecommunication feature, the inquiry is processed, and appropriate software modules are assembled to enable the requested feature. After this event, if user lifts a handset to originate a call, the requested feature is available (C. 6, L. 1-17).

Conclusion

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to:

(703) 872-9306   [Official communications; including After Final communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

Igor Borissov
Patent Examiner
Art Unit 3629

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12/26/2004